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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

EIS-5799 DIV.1 (112713-1150)

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name _____

Application Number

10/720,765

Filed

November 24, 2003

First Named Inventor

James Martucci, et al.

Art Unit

3626

Examiner

Robert W. Morgan

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

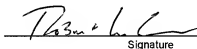
Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/06)

☒ attorney or agent of record.
Registration number 46,639
☐ attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34 _____



Signature

Robert W. Connors

Typed or printed name

312-807-4214

Telephone number

October 8, 2007

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☐ *Total of _____ forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: James Martucci, et al.
Appl. No.: 10/720,765
Conf. No.: 4921
Filed: November 24, 2003
Title: MEDICATION DELIVERY SYSTEM
Art Unit: 3626
Examiner: Robert W. Morgan
Docket No.: EIS-5799 DIV.1 (112713-1150)

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Sir:

In response to the final Office Action dated July 25, 2007, please find the following:

Form PTO/SB/33, Pre-Appeal Brief Request for Review;

Form PTO/SB/31, Notice of Appeal; and

Remarks beginning on page 2 of this paper.

REMARKS

This Paper, the Notice of Appeal, and Pre-Appeal Brief Request for Review are submitted in response to the rejection of claims 1 to 6 maintained in the Final Office Action dated July 25, 2007, which Appellants respectfully submit rises to the level of clear error, making the case proper for pre-appeal review.

Please charge deposit account 02-1818 for the Notice of Appeal and any other fees deemed owed.

The Office Action rejected claims 1 to 6 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,671,563 to Engelson et al. ("*Engelson*"). Appellants respectfully traverse this rejection for at least the reasons set forth below.

Rejection of Claims 1 to 5 under 35 U.S.C. § 102(e)

Independent claims 1 and 5 each recite, in part, "providing a handheld computing device with: means for reading the prescribed medication data and medication delivery instruction from the first label and patient data from the second label . . . the handheld computing device reading the prescribed medication data and medication delivery instruction from the first label; the handheld computing device reading the patient data from the second label." Appellants respectfully submit that the Office Action has failed to make a proper anticipation rejection because *Engelson* does not teach at least these limitations.

Appellants argued in the Response to Office Action dated May 17, 2007, among other things, that the portable computer 235 of *Engelson* does not include means for reading the prescribed medication data and medication delivery instruction from the first label and patient data from the first second label. The Final Office Action responded by asserting that *Engelson* teaches care management system (30, Fig. 1) that includes, attached to the pharmacy CPU, a bar code reader (68, Fig.1), which is adapted to read barcode labels that may be attached to drug containers, equipment, or caregivers identification badges. (See, Office Action, pg. 9). The Final Office Action concluded that the care management system "can be a portable computer (235, Fig. 15)" and the system "can be portable and include a means for reading bar codes such as bar code reader." (Office Action, pg. 9).

Appellants respectfully submit that this is incorrect. The barcode reader 68 of *Engelson* is attached to pharmacy CPU 60, which is located in the pharmacy. (See, Fig. 2, column 5, lines

36-48). Barcode reader 90 is attached to bedside computer 80 in one embodiment (See, Fig. 2, column 6, lines 36-47) and connected to a wireless R/F transmitter/receiver in another embodiment. (See, column 15, lines 40-43). Thus, the portable computer 235 of *Engelson* does not include barcode reader 68 nor barcode reader 90. *Engelson*, therefore, fails to teach, “a handheld computing device with: means for reading the prescribed medication data and medication delivery instruction from the first label and patient data from the second label” as called for in each of independent claims 1 and 5.

Moreover, since the portable computer 235 of *Engelson* does not include barcode reader 68 or 90, it also does read medication delivery instructions from the first label and read medication data from a second label. Thus, *Engelson* also fails to teach, “the handheld computing device reading the prescribed medication data and medication delivery instruction from the first label; the handheld computing device reading the patient data from the second label” as called for in each of independent claims 1 and 5. *Engelson*, therefore, does not anticipate claims 1 and 5. Appellants respectfully request that the rejection of claims 1 and 5 under 35 U.S.C. § 102(e) be withdrawn.

Claims 2 to 4 are all depend from claim 1 and include all of the limitations of claim 1. Accordingly, the patentability of each of these claims flows from the patentability of claim 1. Applicants, therefore, respectfully request the rejections of claims 2 to 4 under 35 U.S.C. § 102(e) over *Engelson* be withdrawn for at least the reasons provided above for claim 1.

Rejection of Claim 6 under 35 U.S.C. § 102(e)

Similar to independent claims 1 and 5, claim 6 recites, in part, “the handheld computing device having: means for reading the prescribed medication data and medication delivery instruction from the first label and patient data from the second label.” Appellants respectfully submit that the Office Action has failed to make out a proper anticipation rejection of claim 6 because *Engelson* does not teach at least this limitation.

In the Response to Office Action dated May 17, 2007, Appellants made an argument for claim 6 similar to claims 1 and 5, i.e., that the portable computer 235 of *Engelson* does not include, among other things, means for reading the prescribed medication data and medication delivery instruction from the first label and patient data from the second label. The Final Office

Action responded with the same assertions for claim 6 as it did with respect to claims 1 and 5. (See, Office Action, pg. 9).

Therefore, for at least the same reason given with respect to claims 1 and 5, that *Engelson* does not include a handheld computing device having, “means for reading the prescribed medication data and medication delivery instruction from the first label and patient data from the second label”, Appellants respectfully submit that *Engelson* also does not anticipate claim 6. Appellants respectfully request that the rejection of independent claim 6 under 35 U.S.C. § 102(e) be withdrawn.

For at least the foregoing reasons, Appellants respectfully submit that the rejection of claims 1 to 6 under 35 U.S.C. § 102(e) as being anticipated by *Engelson* be withdrawn and the claims of the application be allowed.

Respectfully submitted,

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BY



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Dated: October 8, 2007